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PICKER INTERNATIONAL INC
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EXAMINER	
PATENTS, E	
PAPER NUMBER	

DATE MAILED:

04/06/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
08/756,257

Applicant(s)
Schellenberg

Examiner
Eleni Mantis Mercader

Group Art Unit
3737

☒ Responsive to communication(s) filed on Nov 25, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-35 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-35 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 is rejected because it is a single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, and is rejected due to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

Double Patenting

3. Claims 1-35 are rejected under the judicially created doctrine of double patenting over claims 6, 16 and 22 of U. S. Patent No. 5,517,990 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Kalfas et al. disclose an apparatus for guiding the movement of a surgical tool in relation to the anatomy of a patient (col. 8, lines 13-50), the apparatus comprising means for indicating the difference between the actual and the position of the tool (col. 3, lines 33-53), the tool having emitters mounted to the frame assembly (col. 5, lines 10-44), and having the trajectory and location of the tool being superimposed on an image to guide the physician (col. 4, lines 7-16). Kalfas et al. teach in one embodiment the use of emitters which are perpendicular to the axis of the frame of the tool (col. 5, lines 22-26). The surgeon can determine the threshold of the desired location according to the superposition of the trajectory on to the previously acquired images (col. 4, lines 17-35). The emitters on the probe provide an indication of the difference between the actual and the desired positions (col. 8, lines 51-64).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schmeller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Kalfas et al.

Kalfas et al. disclose an apparatus for guiding the movement of a surgical tool in relation to the anatomy of a patient (col. 8, lines 13-50), the apparatus comprising means for indicating the difference between the actual and the position of the tool (col. 3, lines 33-53), the tool having emitters mounted to the frame assembly (col. 5, lines 10-44), and having the trajectory and location of the tool being superimposed on an image to guide the physician (col. 4, lines 7-16). Kalfas et al. teach in one embodiment the use of emitters which are perpendicular to the axis of the frame of the tool (col. 5, lines 22-26). The surgeon can determine the threshold of the desired location according to the superposition of the trajectory on to the previously acquired images (col. 4, lines 17-35). The emitters on the probe provide an indication of the difference between the actual and the desired positions (col. 8, lines 51-64).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(f) he did not himself invent the subject matter sought to be patented.

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7. Claims 1-35 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The inventor was not part of the inventive entity of Kalfas et al. in patent 5,517,990.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schulz discloses an apparatus for determining the position and orientation of an invasive portion of a probe inside a three dimensional space.

Cosman discloses a process of stereotactic optical navigation.

Kormos et al. disclose a magnetic resonance stereotactic surgery with exoskeleton tissue stabilization.

Kormos et al. disclose a frameless stereotaxy system.

Bova et al. disclose a repeat fixation for frameless stereotactic procedure.

Heilbrun et al. disclose an apparatus and method for photogrammetric surgical localization.

Glassman et al. disclose an image-directed robotic system for precise robotic surgery including redundant consistency checking.

Dow et al. disclose a laparoscopic ultrasonic probe.

Examiner notes that the teachings by Rapaport et al. IEEE Trans. of Biomedical Engrg. Vol. BME-26 No. 6 June 1979, pp. 345-349, are relevant to the current application and will

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provide a copy to the applicant for consideration with the next office action or as soon as the reference is available to examiner.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is (703) 308-0899. The examiner's supervisor, Mr. Marvin Lateef, can be reached on (703) 308-3256.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. The fax phone number for this group is (703) 308-3590.



MARVIN M. LATEEF
SUPERVISORY PATENT EXAMINER
GROUP 3300



EMM

March 28, 1998.